



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,415	12/09/2004	Jan-Olof Svensson	47253-00041USPX	8361

23932 7590 06/23/2005

JENKENS & GILCHRIST, PC
1445 ROSS AVENUE
SUITE 3200
DALLAS, TX 75202

EXAMINER

TIBBITS, PIA FLORENCE

ART UNIT	PAPER NUMBER
----------	--------------

2838

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/506,415

Applicant(s)

SVENSSON ET AL.

Examiner

Pia F. Tibbits

Art Unit

2838

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-11 is/are rejected.
- 7) ☒ Claim(s) 5-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/17/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is in answer to the preliminary amendment filed 8/31/2004. Claims 1-11 are pending.

Priority

1. This application claims priority from PCT/EP03/01548 filed 2/14/2003, and provisional application filed 3/8/2002. However, according to the papers submitted, the PCT priority date is 4/3/2002. Applicant needs to clarify.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the conventional names, as described in the specification, e.g. controller, regulator, etc. for the elements 5 and 44, shown with non-conventional symbols. Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

4. Claims 1-11 are objected to because of the following informalities:

a) all claims are generally narrative and indefinite, failing to conform to current U.S. practice.

They appear to be a literal translation into English from a foreign document and contain grammatical and idiomatic errors.

b) the reference numbers need to be removed from all claims, as they are part of different embodiments.

Art Unit: 2838

c) claims 5-7 are objected to under 37 CFR 1.75(c) as being in improper form because they depend upon a multiple dependent claim 4. See MPEP § 608.01(n). Accordingly, claims 5-7 have not been further treated on the merits.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by **Celenza et al.** [hereinafter Celenza][5049805].

Celenza discloses in figures 1-3 a power supply arrangement for supplying power from a battery 12 to an electric load/ computer system [see fig.3], said arrangement comprising: a controlled switch Q5 having a first state in which a connection is provided from the battery 12) to the load, and a second state in which the load is disconnected from the battery 12, and control circuitry 14 [see fig.1] for controlling the state of the controlled switch Q5, characterized in that the control circuitry 14 is arranged to be disconnected from the battery 12 when the controlled switch Q5 is in its second state [see column 5, lines 29-40; column 6, lines 5-7].

As to claims 3 and 4, see reference and remarks for claim 1 above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2838

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over prior art disclosed by applicant, **Tamai** [5477124].

Tamai discloses in figures 1 and 2 a power supply arrangement for supplying power from a battery 21 to an electric load 1 said arrangement comprising: a controlled switch 2 having a first state in which a connection is provided from the battery 21 to the load 1. Tamai does not disclose a second state in which the load is disconnected from the battery, and control circuitry 6 for controlling the state of the controlled switch 2 characterized in that the control circuitry 6 is disconnected from the battery 21 when the controlled switch 2 is in its second state. However, Tamai discloses a second switch 5 that disconnects the control circuitry 6 from the battery 21 [see column 2, lines 28-30; column 3, lines 18-21]. With regard to the patent using two switches to disconnect the load and the control circuitry: eliminating one switch, cited in the Tamai reference, applicant neither extends the life of the battery being used as a main power supply, nor makes it easier to protect the battery from over discharge in case of a failure of the first switch, which is the object of his invention, as cited in the disclosure. Therefore it would be obvious to one skilled in the art at the time the invention was made that the elimination of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before. See *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989), *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over prior art disclosed by applicant, **Tamai** [5477124] in view of **Arnet et al.** [hereinafter Arnet] [6768621].

Tamai does not disclose a switch arranged to be operated manually provided in parallel to the controlled switch.

Arnet discloses in figures 1-10 a switch arranged to be operated manually provided in parallel to the controlled switch in order to be able to shut the system down in the event the controlled switch unintentionally opens during operation [see column 2, lines 42-45; column 3, line 66].

Art Unit: 2838

10. Claims 3, 4, 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over prior art disclosed by applicant, **Tamai**, as described above, in view of **Hwang** [4704542].

Tamai does not disclose a back-up power storage for supplying power to the control circuitry, when the controlled switch is in its second state, i.e., disconnected.

Hwang discloses in the figure a back-up power storage 20 for supplying power to control circuitry 10 to provide stand-by power supply in case the main power supply fails [see column 2, line 18]. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Tamai's apparatus and include a back-up power storage 20, as disclosed by Hwang, in order to provide a stand-by power supply in case the main power supply fails.

As to claim 4, Tamai clearly discloses FET's.

With respect to the method claims 8-11: the method steps will be met during the normal operation of the apparatus described above.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related apparatus.

Art Unit: 2838

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Pia Tibbits whose telephone number is (571) 272-2086. If unavailable, contact the Supervisory Patent Examiner Mike Sherry whose telephone number is (571) 272-2084. The Technology Center Fax number is (703) 872-9306.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PFT

June 20, 2005

Pia Tibbits

Primary Patent Examiner

